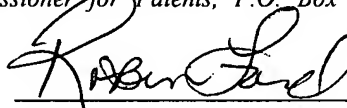




PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April 20, 2007.*

  
Robin Ford

Applicant : Lutz Biedermann, et al. Confirmation No. 7913  
Application No. : 10/799,143  
Filed : March 11, 2004  
Title : ANCHORING ELEMENT FOR USE IN SPINE OR BONE SURGERY,  
METHODS FOR USE AND PRODUCTION THEREOF  
  
Grp./Div. : 3733  
Examiner : Mary C. Hoffman  
  
Docket No. : 56717/B884

**INFORMATION DISCLOSURE STATEMENT**  
**37 CFR § 1.97(b)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Post Office Box 7068  
Pasadena, CA 91109-7068  
April 20, 2007

Commissioner:

In compliance with the duty of disclosure under 37 CFR §§ 1.56, 1.97 and 1.98, and in accordance with the provisions in the Manual of Patent Examining Procedure §§ 609 and 707.05(b), enclosed is FORM PTO/SB/08A/B listing the references that are known to applicant. Copies of each of the listed OTHER DOCUMENTS are enclosed. This filing is timely because it is made during one of the periods described in 37 CFR § 1.97(b).

It is respectfully requested that the listed references be considered in the examination of this application and identified on the list of references cited on the patent issuing for this application. Applicant also requests that an initialed copy of FORM PTO/SB/08A/B be entered in the application file and returned to applicant with the next communication from the Office in accordance with MPEP § 609.

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The Commissioner is hereby authorized to charge any fees which may be required by this paper to Deposit Account No. 03-1728. Please show our docket number with any Deposit Account transaction.

This Information Disclosure Statement contains references mailed to the Office in two separate submissions by a third party on November 15, 2004.

One of the references submitted to the Office relates to the present application, namely U.S. Patent No. 5,474,555 to Puno, and assigned to Cross Medical Products (the Cross patent). The owner of the present application, Biedermann Motech GmbH, is familiar with the Cross patent because it was asserted against its exclusive licensee in a confidential arbitration proceeding, which is now concluded. The Cross patent was also asserted in litigation against Medtronic Sofamor Danek, Inc. In the Medtronic litigation, Cross asserted that a Medtronic screw infringed claim 5 of the Cross patent.

In a recent U.S. Court of Appeals for the Federal Circuit decision, *Cross Medical Products, Inc. v. Medtronic Sofamor Danek, Inc.* (05-1415, March 20, 2007), the Court found that a Medtronic screw that "replaced the threading that extends below the diameter of a rod in its original screws with an undercut that does not engage any surface of the corresponding set screw" does not infringe claim 5 of the Cross patent under the doctrine of equivalents because "the use of an undercut or recess, the alleged equivalent here, is an old and well known fundamental of basic machining that was entirely foreseeable at the time of the amendment to one of ordinary skill in the art. See, e.g., John R. Walker, *Machining Fundamentals, Fundamentals Basic to Industry*, at 185-86 (1981); U.S. Patent No. 5,129,900; U.S. Patent No. 5,190,543". See pages 8 and 12-13 of the Federal Circuit decision attached to the accompanying Information and Disclosure Statement.


For purposes of examining this application only, Applicant admits that a design change to the Cross patent calling for the threads to end at a depth above the diameter of the rod with an undercut extending below the diameter of the rod was foreseeable to a person of skill in the art at the time of the invention described in the present application and that it was known, at the time of the invention described in the present application, to provide systems in which threads

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terminated above the rod and set screws that extended below the threads were used to apply compressive forces to a rod.

Respectfully submitted,

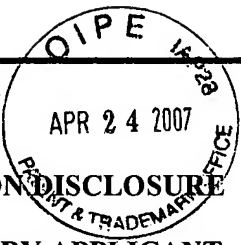
CHRISTIE, PARKER & HALE, LLP

By   
Mark Garscia  
Reg. No. 31,953  
626/795-9900

MEG/rjf

Enclosures: PTO/SB/08A/B, w/references

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**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(use as many sheets as necessary)

**Attorney Docket Number**

**56717/B884**

**Application Number**

**10/799,143**

**Filing Date**

**March 11, 2004**

**Applicant(s)**

**Lutz Biedermann, et al.**

**Group Art Unit**

**3733**

**Examiner Name**

**Mary C. Hoffman**

**U.S. PATENT DOCUMENTS**

EXAMINER INITIALS	Cite No. <sup>1</sup>	DOCUMENT NUMBER Number - Kind Code <sup>2</sup> (If Known)	PUBLICATION DATE MM-DD-YYYY	NAME OF PATENTEE
		5,129,900	07-14-1992	Asher et al.
		5,190,543	03-02-1993	Schlöpfer
		5,217,497	06-08-1993	Mehdian
		5,474,555	12-12-1995	Puno et al.
		US 2004/0186473 A1	09-23-2004	Cournoyer et al.

**FOREIGN PATENT DOCUMENTS**

EXAMINER INITIALS	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> - Number <sup>4</sup> - Kind Code <sup>5</sup> (If Known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	T <sup>6</sup> (✓)

**OTHER DOCUMENTS**

EXAMINER INITIALS	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article, title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
		WALKER, John R., <u>Machining Fundamentals - Fundamentals Basic to Industry</u> , 1981, pages 2, 179-186, The Goodheart-Willcox Co., Inc., South Holland, Illinois
		LASCOE et al. <u>Machinshop - Operations and Setups</u> , 1973, pages 380, 386, and 388, 4th Edition, American Technical Society, Chicago
		Opinion, 05-1415, March 20, 2007, U.S. Court of Appeals for the Federal Circuit, Cross Medical Products, Inc. v. Medtronic Sofamor Danek, Inc.

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EXAMINER SIGNATURE	DATE CONSIDERED
EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at <a href="http://www.pto.gov">www.pto.gov</a> or MPEP 901.4. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English Language Translation is attached.	

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